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**MAY 25 2006**

**OFFICE OF PETITIONS**

In re Application of	:	
Andreas Giefer	:	DECISION ON PETITIONS
Application No. 09/600,832	:	
Filed: July 21, 2000	:	
Attorney Docket No. 67526	:	

This is decision on the petition under 37 C.F.R. 1.183, filed January 23, 2006, to waive the period to respond to an *Ex parte Quayle* action mailed March 22, 2005. This is also a decision on the petition under 37 CFR 1.137(a) to revive the above-identified application.

On March 22, 2005, the Office mailed an *Ex parte Quayle* action, which set a two-month shortened statutory period to reply. Extensions of time for response were permitted under 37 CFR 1.136(a). On May 20, 2005, applicant submitted a response to the *Ex parte Quayle* action. On June 7, 2005, the Office mailed an Advisory Action, indicating that the proposed changes of May 20, 2005, would not be entered because the proposed amendment to the specification and to the drawings raised the issue of new matter. On June 24, 2005, applicant filed a petition under 37 CFR 1.181 to invoke supervisory review of the Advisory Action of June 7, 2005. The petition was dismissed by the decision of September 26, 2005. On November 1, 2005, applicant filed a renewed petition under 37 CFR 1.181 and proposed further amendments to the drawings. On December 14, 2005, the Office mailed a decision denying the renewed petition. The decision stated that the period to respond with any extensions of time expired on September 22, 2005. However, as petitioner did not obtain any extensions of time to respond to the *Ex parte Quayle* action of June 21, 2005, the application became abandoned as of the expiration of the two-month shortened statutory period for reply, *i.e.* May 23, 2005. On January 23, 2006, applicant filed the present petitions.

**Petition under 37 CFR 1.183**

In essence, applicant requests that the Office permit applicant to extend the period for filing a response beyond the six-month statutory period set forth in the *Ex parte Quayle* action of March 22, 2005. The

Office notes that the abandonment of an application takes place by operation of law for failure to timely submit a proper reply to an Office action.

In an extraordinary situation, when justice requires, any requirement of the regulations, **which is not a requirement of the statutes** may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. 37 CFR 1.183.

An applicant may extend the shortened period for reply to an *Ex parte Quayle* action within the limits of the statutory six-month period; however, no extension can operate to extend the time beyond the six months. An applicant must file a reply prior to the expiration of the period to avoid abandonment of the application as indicated in 35 U.S.C. § 133.

As indicated above, the USPTO is not permitted to waive the requirements of the statutes. Assuming, *arguendo*, the Office could waive the requirements, equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable due care and diligence. See United States v. Lockheed Petroleum Servs., 709 F.2d 1472, 1475 (Fed. Cir. 1983).

Furthermore, where the Office has the power to do so, it should not relax the requirements of established practice to save an applicant from the consequence of his delay. See Ex Parte Sassin, 1906 Dec. Comm'r. Pat. 205, 206 (Comm'r Pat. 1906) and compare Ziegler v. Baxter v. Natta, 159 USPQ 378, 379 (Comm'r Pat. 1968). Circumstances resulting from applicant's, or applicant's counsel's, failure to exercise due care or to properly apply the patent statutes or rules of practice are not extraordinary circumstances where the interests of justice require the granting of relief. See In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pat. 1990).

Accordingly, the petition under 37 CFR 1.183 is **dismissed**.

#### **Petition under 37 CFR 1.137(a)**

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.
- (2) The petition fee as set forth in 37 CFR 1.17(l);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable.

The Director may require additional information where there is a question whether the delay was unintentional; and

(4) Any terminal disclaimer (and fee set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

This petition lacks items (1) and (3) above.

As to item (1), the examiner reviewed the reply submitted on January 23, 2006. The examiner responded as follows:

I respectfully submit that the Amendment should not be entered because of the reasons, *inter alia*, listed below:

(a) The Amendment did not comply with 37 CFR 1.121. For example, Applicant's replacement drawings failed to comply with 37 CFR 1.84 as seen in Form PTO-948 attached. Please see 37 CFR 1.121(d) quoted below:

37 CFR 1.121(d) Drawings:

One or more application drawings shall be amended in the following manner: ***Any changes to an application drawing must be in compliance with § 1.84*** and must be submitted on a replacement sheet of drawings which shall be an attachment to the amendment document and, in the top margin, labeled "Replacement Sheet". Any replacement sheet of drawings shall include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. Any new sheet of drawings containing an additional figure must be labeled in the top margin as "New Sheet". All changes to the drawings shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper. (Emphasis added)

(b) The Amendment in the specification is inconsistent with the drawings or vice versa. For example, (1) the replacement paragraph starting on page 6, line 18, describes two deflection axes 16, but the referential numerals 16 are not shown in the drawings; (2) Fig. 7 shows the referential numeral 11, however, the specification does not describe the structural element 11; and (3) the replacement paragraph starting on pages 9 at line 17 describes the bracket and the clamp in Fig. 7, however, Fig. 7 does not have the referential numerals to designate the bracket and the clamp. Please see MPEP 608.02; and/or

(c) The replacement drawings introduce new matter. For example, the original Figs. 6 and 7 show that the lever 8 includes a slot 8', however, the corrected 4 and 5 show that the lever 8 is a solid rod without the slot. The concept that the lever 8 is solid rod without the slot is not present in the original disclosure, thus, it is new matter.

Additionally, the draftsman reviewed the drawings submitted on November 1, 2005, and January 23, 2006. The draftsman objected to the drawings and indicated that corrected drawings were necessary. The Notice of Draftsman's Patent Drawing Review accompanies this decision.

As to item (3), the Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to be "unavoidable".<sup>1</sup> Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.<sup>2</sup>

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).<sup>3</sup> Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.<sup>4</sup>

A delay is not unavoidable when an applicant fails to comply with a requirement set forth in an Office action, which necessitates a response within a specified time period. Additionally, an applicant may delay action until the end of the time period for reply. However, in doing so, the applicant must assume the risk attendant to such delay.<sup>5</sup> A delay resulting from the lack of knowledge or improper

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<sup>1</sup>35 U.S.C. § 133.

<sup>2</sup>In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

<sup>3</sup>See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay.

<sup>4</sup>Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

<sup>5</sup>Ex parte Warren, 1901 Dec. Comm'r Pat. 137 (Comm'r Pat. 1901).

application of the patent statute, a rule of practice or the MPEP does not constitute an “unavoidable” delay.<sup>6</sup>

The USPTO notes that applicant’s arguments set forth in the present and previously filed petitions have been considered thoroughly by both the Group Director and the Office of Petitions. The Office of Petitions concurs with the decisions of the Group Director.

In the present case, the file record reveals that petitioner did not take appropriate action to ensure that a proper response was timely filed so as to prevent the application from becoming abandoned. It is clear that that abandonment of an application is risked when an applicant files an amendment after an *Ex parte Quayle* action. Moreover, as stated in the denial of December 14, 2005: “The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. . . .”

Under the decision in *Ex parte Quayle*, 25 USPQ 74, 1935 C.D. 11; 453 O.G. 213 (Comm’r Pat. 1935), after all claims in an application have been allowed the prosecution of the application on the merits is closed even though there may be outstanding formal objections which preclude fully closing the prosecution. Amendments touching the merits are treated in a manner similar to amendments after final rejection, though the prosecution may be continued as to the formal matters. See MPEP 714.12 and 714.13. After an applicant has been notified that the claims are all allowable, further prosecution of the merits of the application is a matter of grace and not of right. *Ex parte Quayle*, 25 USPQ 74, 1935 C.D. 11; 453 O.G. 213 (Comm’r Pat. 1935); MPEP 714.15

A reply to an *Ex parte Quayle* action may be entered if it presents an amendment that *prima facie* places the application in condition for allowance. The mere filing of an amendment does not save the application from abandonment. Further, the entry of an amendment filed after an *Ex parte Quayle* action is not a matter of right, and thus, it is incumbent upon an applicant to take steps to ensure against abandonment of an application. Therefore, the above-identified application became abandoned and continues to remain abandoned due to applicant’s failure to file an appropriate and timely response to the *Ex parte Quayle* action.

Accordingly, as applicant has not satisfied the requirements of a grantable petition under 37 CFR 1.137(a), the petition to revive the application due to unavoidable delay is **dismissed**.

#### ALTERNATIVE VENUE

Applicant is strongly encouraged to consider filing a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application instead of filing a renewed petition.

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed. In nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed

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<sup>6</sup> See *Haines v. Quigg*, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987).

on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) The petition fee as set forth in 37 CFR 1.17(m), **an additional** \$1,500.00 for a large entity and \$750.00 for a small entity;

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and

(4) A terminal disclaimer (and fee set forth in § 1.20(d)) **if required** pursuant to 37 CFR 1.137(d).

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.183 and/or 37 CFR 1.137(a)." Extensions of time are permitted under 37 CFR 1.136(a).

Further correspondence with respect to this matter should be addressed as follows:

By mail:                      Mail Stop Petition  
                                    Commissioner for Patents  
                                    P.O. Box 1450  
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By FAX:                      (571) 273-8300  
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By hand:                     Customer Service Window  
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                                    401 Dulany Street  
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Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3211.

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Enclosure: Notice of Draftsperson's Patent Drawing Review